

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**

REMARKS

Claims 19-28 and 30-40 are all the claims pending in the application. Claims 1-18 and 29 have been canceled without prejudice or disclaimer. New claims 36-40 have been added to further define the invention. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Information Disclosure Statement (IDS)

The Examiner has not considered SU 3 943 191, because he asserts that it “was not filed in either application 09/859,044 or 09/471,232.”¹ However, contrary to the Examiner’s assertion, this reference was made of record during the prosecution of both parent application Nos. 09/859,044 (hereinafter the ‘044 application) and 09/471,232 (hereinafter the ‘232 application).

In an Office Action mailed on May 9, 2001,² in the ‘232 application, Examiner N. Fayyaz cited on a PTO-892 document number “3,943,191” published “12/1986” from the country of “Russia” in the name of “Shvartsman”. Together with this PTO-892, the Examiner provided a copy of the reference document number “1985 SU-3943191” dated “08/1985” in the name of “Shvartsman”. It is believed that the Examiner mistakenly identified “Russia” instead of “Soviet Union” as designated by the “SU” country code on the copy of the reference as provided.

In the ‘044 application, filed as a divisional of the ‘232 application, Applicants cited document “3,943,191” dated “12/1986” from the country of “SU” in an attempt to correct Examiner Fayyaz’s apparent error. In an Office Action mailed on March 31, 2003,³ Examiner Katherine A. Bareford considered and initialed next to this document as cited on the PTO form-

¹ Office Action at page 2, item 1.

² A copy of this Office Action, together with the reference as provided by the USPTO, is submitted herewith for the Examiner’s convenience.

³ A copy of this Office Action is submitted herewith for the Examiner’s convenience.

1449 submitted in the ‘044 application listing all the references cited during prosecution of the ‘232 application.

Therefore, to be consistent with the ‘044 application and again to correct Examiner Fayyaz’s apparent error, on the PTO form-1449 submitted on October 6, 2003 in the present application, Applicants cited the reference as document “3,943,191” published “12/1986” from the country of “SU”.

In light of the above, Applicants respectfully request that the Examiner consider and initial next to the document “3,943,191” published “12/1986” from the country of “SU”, as listed on the PTO form-1449 submitted October 6, 2003 in the present application.

Drawings

The Examiner asserted that Fig. 15 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. Applicants have submitted herewith one Replacement Drawing Sheet (14/14), wherein Fig. 15 is labeled as --Prior Art--.

Specification

The Examiner objected to the abstract of the disclosure as being more than 150 words. Accordingly, Applicants have amended the abstract of the disclosure so as to comply with the 150 word limit.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 19-35 under §112, 2nd paragraph, as being indefinite. Specifically, the Examiner asserted that the recitation “relatively approaching” is indefinite. Applicants have amended this phrase so as to recite that the application control unit “moves at least one of ... with respect to one another”. Accordingly, this rejection is believed to have been overcome. These amendments to claims 19, 20, 27, and 29, were made merely to more accurately claim the present invention, do not narrow the literal scope of the claims, were not made for reasons of patentability and thus, do not implicate an estoppel in the application of the doctrine of equivalents.

Allowable Subject Matter

Applicants thank the Examiner for indicating that claims 20, 25, 26, 29, 34, and 35, would be allowable if rewritten in independent form and to overcome the rejections under § 112, 2nd paragraph. In order to expedite prosecution of this application, Applicants have: written claim 20 in independent form by incorporating the subject matter thereof into claim 19; written claim 29 in independent form by incorporating the subject matter thereof into claim 27; and have written claim 25 in independent form as new claim 36. Additionally, new claims 37-40 have been added as dependent from new claim 36. Further, as noted above, the rejection under § 112, 2nd paragraph, is believed to have been overcome. Accordingly, claims 19-28 and 30-40 should be in condition for immediate allowance.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Jeffrey A. Schmidt
Registration No. 41,574

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: July 14, 2004



31514

UNITED STATES DEPARTMENT OF COMMERCE**Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

AK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/12/2001 10/12/2004 SERLINE

10/07/2004

MURKIN, MILAN & INN MACPEAK & SEARS PLLC
2121 PENNSYLVANIA AVENUE N.W.
WASHINGTON DC 20037

100-117639

EXAMINER

FAYYAZ, N

ART UNIT

PAPER NUMBER

2654

DATE MAILED:

06/14/2004

DOCKETE #
MAY 11 2001**Please find below and/or attached an Office communication concerning this application or proceeding.****Commissioner of Patents and Trademarks**



Office Action Summary

Application No. 09/471,232	Applicant(s) Sekine et al
Examiner Nashmiya Fayyaz	Art Unit 2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Mar 20, 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) 1-12, 15, and 16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13, 14, 17, and 18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

Art Unit: 2856

1. Applicant's election without traverse of Group II, species V in Paper No. 7 is acknowledged.
2. Claims 1-12, 15 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected Invention/species. Election was made **without** traverse in Paper No. 7.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13, 14, 17, ^{and} ~~18~~ are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Smith et al. - US Patent #4,738,336.

As to claims 13, 14, 17 and 18, Smith et al. disclose a controlled lubrication replenishing system including bearing housing 12, with bearing sets 34/26 with rolling elements 18 in cage 20, sensor 32 with leds 40/42 and photo sensors 44/46, lubricant pump means 52 with discharge conduit 53 for pumping lubricant to bearing 24/26, and further a control system 54 monitors the speed ratio which is representative of the lubricant film thickness and controlling subsequent lubricant, see figs. 1-3 and col. 2, lines 61 et seq.

5. Claims 13, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) clearly as being clearly anticipated by Yamada U.S Patent #5,076,397.

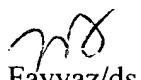
Art Unit: 2856

As to claims 13, 14 17 and 19, Yamada discloses an oil lubricant condition sensing system for a bearing including shaft 14 in bearing 21 with lubricant continued in reservoir filled though opening 35 and further including sensor 41 with light emitter 43 and light receiver 44 and finally an oil conditioning deciding circuit 44, see col. 2, lines 55 et seq and Figs. 2-3.

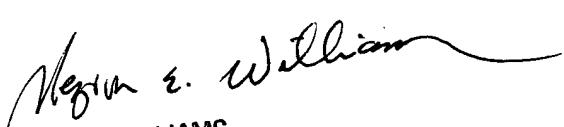
6. Claims 13, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP - 106196 - Kurokawa.

As to claims 13, 14, 17 and 18, Kurokawa discloses a lubricating oil supply supervising device including lubricant supply 1, feed pipe 3, bearing 2, light sensor 15, light source 17 and count, comparing portion 25 and judging portion 26 to judge whether oil is properly supplied to a portion to be lubricated see abstract and fig. 1.

7. Any inquiry concerning this communication should be directed to n. Fayyaz at telephone number (703) 308-4891.


Fayyaz/ds

05/05/01


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800



Form PTO-1449
(Rev. 2-32)

~~U.S. Department of Commerce~~
Patent & Trademark Office

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication.

Notice of References Cited		Applicant/Patent Sekine et al	Application/Control No. 09/471,232
		Examiner Nashmiya Fayyaz	Art Unit 2856
		Page 1 of 1	

O I P E S C 1 A
PATENT & TRADEMARK OFFICE
PATENT DOCUMENTS

	Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Name	Classification ²	
A	4,152,598	5/1979	Stewart	250	391
B	4,738,336	4/1988	Smith et al	184	6.4
C	5,076,397	12/1991	Yamada	184	6.4
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

FOREIGN PATENT DOCUMENTS

	Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Country	Name	Classification ²	
N	106,196	5/1987	Japan	Kurokawa	184	6.4
O	3,943,191	12/1986	Russia	Shvartsman	----	----
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS

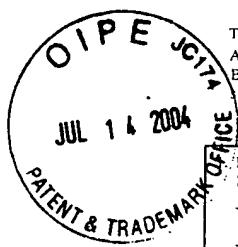
	Include, as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages
U	
V	
W	
X	

* A copy of this reference is not being furnished with this Office action. See MPEP § 707.05(a).

¹ Dates in MM-YYYY format are publication dates.

² Classifications may be U.S. or foreign.

NOTICE OF DRAFTSPERSON'S PATENT DRAWING REVIEW



The drawing(s) filed (insert date) 11237132 are:

- A. approved by the Draftsperson under 37 CFR 1.84 or 1.152.
 B. objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawing must be submitted according to the instructions on the back of this notice.

<p>DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings: Black ink. Color. <input type="checkbox"/> Color drawings are not acceptable until petition is granted. Fig(s) _____</p> <p><input type="checkbox"/> Pencil and non black ink not permitted. Fig(s) _____</p> <p>2. PHOTOGRAPHS. 37 CFR 1.84 (b) <input type="checkbox"/> 1 full-tone set is required. Fig(s) _____ <input type="checkbox"/> Photographs not properly mounted (must use bristol board or photographic double-weight paper). Fig(s) _____ <input type="checkbox"/> Poor quality (half-tone). Fig(s) _____</p> <p>3. TYPE OF PAPER. 37 CFR 1.84(e) <input type="checkbox"/> Paper not flexible, strong, white, and durable. Fig(s) _____ <input checked="" type="checkbox"/> Erasures, alterations, overwritings, interlineations, folds, copy machine marks not accepted. Fig(s) <u>11237132</u> <input type="checkbox"/> Mylar, velum paper is not acceptable (too thin). Fig(s) _____</p> <p>4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes: <input type="checkbox"/> 21.0 cm by 29.7 cm (DIN size A4) <input type="checkbox"/> 21.6 cm by 27.9 cm (8 1/2 x 11 inches) <input type="checkbox"/> All drawing sheets not the same size. Sheet(s) _____ <input type="checkbox"/> Drawings sheets not an acceptable size. Fig(s) _____</p> <p>5. MARGINS. 37 CFR 1.84(g): Acceptable margins: Top 2.5 cm Left 2.5cm Right 1.5 cm Bottom 1.0 cm SIZE: A4 Size Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm SIZE: 8 1/2 x 11 Margins not acceptable. Fig(s) _____ <input type="checkbox"/> Top (T) <input type="checkbox"/> Left (L) <input type="checkbox"/> Right (R) <input type="checkbox"/> Bottom (B)</p> <p>6. VIEWS. 37 CFR 1.84(h) REMINDER: Specification may require revision to correspond to drawing changes. Partial views. 37 CFR 1.84(h)(2) <input type="checkbox"/> Brackets needed to show figure as one entity. Fig(s) _____ <input type="checkbox"/> Views not labeled separately or properly. Fig(s) _____ <input type="checkbox"/> Enlarged view not labeled separately or properly. Fig(s) _____</p> <p>7. SECTIONAL VIEWS. 37 CFR 1.84 (h)(3) <input type="checkbox"/> Hatching not indicated for sectional portions of an object. Fig(s) _____ <input type="checkbox"/> Sectional designation should be noted with Arabic or Roman numbers. Fig(s) _____</p>	<p>8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i) <input type="checkbox"/> Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s) _____</p> <p>9. SCALE. 37 CFR 1.84(k) <input type="checkbox"/> Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction. Fig(s) _____</p> <p>10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(i) <input checked="" type="checkbox"/> Lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality). Fig(s) <u>11237132</u></p> <p>11. SHADING. 37 CFR 1.84(m) <input type="checkbox"/> Solid black areas pale. Fig(s) _____ <input type="checkbox"/> Solid black shading not permitted. Fig(s) _____ <input checked="" type="checkbox"/> Shade lines, pale, rough and blurred. Fig(s) _____</p> <p>12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.84(p) <input checked="" type="checkbox"/> Numbers and reference characters not plain and legible. Fig(s) <u>11237132</u> <input checked="" type="checkbox"/> Figure legends are poor. Fig(s) <u>11237132</u> <input type="checkbox"/> Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(1) Fig(s) _____ <input type="checkbox"/> English alphabet not used. 37 CFR 1.84(p)(2) Figs _____ <input type="checkbox"/> Numbers, letters and reference characters must be at least .32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3) Fig(s) _____</p> <p>13. LEAD LINES. 37 CFR 1.84(q) <input type="checkbox"/> Lead lines cross each other. Fig(s) _____ <input type="checkbox"/> Lead lines missing. Fig(s) _____</p> <p>14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t) <input type="checkbox"/> Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Sheet(s) _____</p> <p>15. NUMBERING OF VIEWS. 37 CFR 1.84(u) <input type="checkbox"/> Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____</p> <p>16. CORRECTIONS. 37 CFR 1.84(w) <input type="checkbox"/> Corrections not made from prior PTO-948 dated _____</p> <p>17. DESIGN DRAWINGS. 37 CFR 1.152 <input type="checkbox"/> Surface shading shown not appropriate. Fig(s) _____ <input type="checkbox"/> Solid black shading not used for color contrast. Fig(s) _____</p>
COMMENTS	

REVIEWER _____ DATE _____ TELEPHONE NO. _____

ATTACHMENT TO PAPER NO. _____

DERWENT-ACC-NO: 1987-205134

DERWENT-WEEK: 198729

**COPYRIGHT 1999 DERWENT
INFORMATION LTD**

**TITLE: Evaluation device of oil lubricating
characteristic - has optical
sensor to fix movement of separator under
friction and uses control mechanism
reset separator**

**INVENTOR: SHVARTSMAN, V S H;
VERESNYAK, V P**

**PATENT-ASSIGNEE: BAKASHVILI D
L[BAKAI]**

**PRIORITY-DATA: 1985SU-3943191 (August
6, 1985)**

PATENT-FAMILY:

PUB-NO

PUB-DATE

LANGUAGE

PAGES

MAIN-IPC

SU 1276954 A

December 15, 1986

N/A

003

N/A

APPLICATION-DATA:

PUB-NO

APPL-DESCRIPTOR

APPL-NO

APPL-DATE

SU 1276954A

N/A

1985SU-3943191

August 6, 1985

INT-CL_(IPC): G01N011/00

ABSTRACTED-PUB-NO: SU 1276954A

BASIC-ABSTRACT: Test lubricant is applied to the bearing, loading is applied directions, with a light flow being directed onto ball bearings (9) and onto the lower surface of ring (7) with a semi-transparent coating. Reflected beams

interfere and form an interference pattern, used to determine the oil film thickness according to the number of interference bands at the contact. Friction moves separator (10) from its initial position which is registered by optical sensor (12), the signal from which is registered and passes to a control mechanism, resetting separator (10).

USE - Determination of characteristics of lubricants. Bul.46/ 15.12.86

CHOSEN-DRAWING: Dwg.1/1

TITLE-TERMS:

**EVALUATE DEVICE OIL LUBRICATE
CHARACTERISTIC OPTICAL SENSE FIX
MOVEMENT
SEPARATE FRICTION CONTROL
MECHANISM RESET SEPARATE**

DERWENT-CLASS: S02 S03

**EPI-CODES: S02-A02B2; S02-A03B2;
S03-F03;**

**SECONDARY-ACC-NO:
Non-CPI Secondary Accession Numbers:
N1987-153297**



UNITED STATES PATENT AND TRADEMARK OFFICE

ROA/div
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,044	05/17/2001	Masaaki Sekine	Q64486	3968

7590 03/31/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

BAREFORD, KATHERINE A

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 03/31/2003

8

DOCKETED

APR 02 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

JUL 14 2004

Office Action Summary

Application No.	09/859,044	Applicant(s)	SEKINE ET AL.
Examiner	Katherine A. Bareford	Art Unit	1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 February 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 and 19-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers Claims 13-18 are canceled.

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5
- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. The amendment of Feb. 24, 2003 has been received and entered.

Election/Restrictions

- (*Claims 1-8*)
2. Applicant's election of Group I in Paper No. 7 (Feb. 24, 2003) is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7 (Feb. 24, 2003).

Claim Objections

4. The Examiner notes that claims 3, 7 and 23 indicate that "said discharge port is performed with an oil repellent treatment". The Examiner understands this to correspond to the teaching in the specification at page 12, lines 25-27, that "an oil repellent treatment is carried out on radially outer surfaces of the oil feed pipes 7". However, it would be better to word the claim as "said discharge port has been treated with an oil repellent" so as to provide a more grammatically clear term.

The Examiner further notes that in claims 1 and 21 it is indicated that the discharge port is located "sufficiently close to a rolling element". The Examiner understands this phrase to mean that the port is located "sufficiently close" to the rolling element so that the described transfer of lubricant can occur. If applicant disagrees, the claims should be clarified.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 and 19-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 5 as amended and new claim 21 all require that an the process be part of "an automated production line" (see claim 1, line 5; claim 5, line 4; and claim 21, line 2).
However, applicant has provided no indication of where support for this "automated production line" is provided in the originally filed disclosure and a review of the disclosure by the Examiner provides no basis for this term.

The other dependent claims do not cure the defects of the claims from which they depend.

Response to Arguments

7. Applicant's arguments with respect to claims 1-8 and 19-24 have been considered but are moot in view of the new ground(s) of rejection.

8. As to claims 1-8 and 19-20, the Examiner notes that Johnstone et al (US 4527661)

teaches providing a mist of oil or oil/air onto a rolling bearing from a discharge port. However,
Johnstone does not teach or suggest the use of a holding/rotary table as part of an automated
production line as required by present claims 1 and 5.

As to claims 21-24, the Examiner notes that Johnstone et al (US 4527661) teaches providing a mist of oil or oil/air onto a rolling bearing from a discharge port. Momono et al (US 5443317) teaches the well known provision of a crown shaped retainer for a rolling bearing (see column 1, lines 35-50). However, neither Johnstone or Momono, alone or in combination, teaches or suggests the application of the lubricant to a rolling bearing in an automated production line using a discharge port system as claimed by claim 21.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on M-F(7:00-4:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kath A. Bareford
KATHERINE A. BAREFORD
PRIMARY EXAMINER
GROUP 1700

Notice of References Cited		Application/Control No.	Applicant(s)/Patent Under Reexamination SEKINE ET AL.	
		Examiner Katherine A. Bareford	Art Unit 1762	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-5,443,317	08-1995	Momono et al.	384/491
B	US-4,527,661	07-1985	Johnstone et al.	184/6.1
C	US-			
D	US-			
E	US-			
F	US-	-		
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
U	
V	
W	
X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



SEP 1 0 2007

PTO/SB/08 A & B (modified)

Substitute for Form 1449 A & B/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANTS

(use as many sheets as necessary)

Sheet 1 of 1

Attorney Docket Number Q04480

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document
		Number	Kind Code ² (if known)		
MB		US 4,152,598		05/01/1979	STEWART
VB		US 4,738,336		04/19/1988	SMITH et al.
KB		US 5,076,397		12/31/1991	YAMADA
VO		US 6,324,899	B1	12/04/2001	DISCENZO
		US			

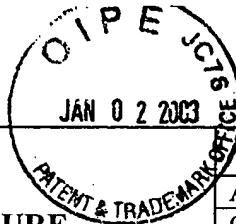
RECEIVED
SEP 17 2002
TC 1700

FOREIGN PATENT DOCUMENTS

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²See Kinds Codes of USPTO Patent Documents at www.uspto.gov, MPEP 901.04 or in the comment box of this document. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to indicate here if English language Translation is attached.



Substitute for Form 1449 A & B/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANTS

(use as many sheets as necessary)

Sheet

1

07

Complete if Known

Application Number	09/859,044
Confirmation Number	3968
Filing Date	May 17, 2001
First Named Inventor	Masaaki SEKINE
Art Unit	1762
Examiner Name	Rebecca A. BLANTON Bareford
Attorney Docket Number	064486

U.S. PATENT DOCUMENTS

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document
		Number	Kind Code ² (if known)		
VB		US 4,256,591		03-17-1981	YAMAMOTO et al.
VB		US 5,021,665		06-04-1991	AMES
VB		US 5,412,219		05-02-1995	CHAPPELLE et al.
VB		US 5,950,588		09-14-1999	KUSCHE et al.
		US			

RECEIVED
JAN 03 2003
TC 1700

FOREIGN PATENT DOCUMENTS

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

Examiner Signature

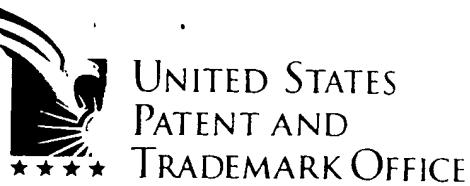
H. Bareford

Date Considered

3/20/03

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²See Kind Codes of USPTO Patent Documents at www.uspto.gov, MPEP 901.04 or in the comment box of this document. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶Applicant is to indicate here if English language Translation is attached.



UNITED STATES
PATENT AND
TRADEMARK OFFICE

FEB 20 2003

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

Dear Patent Business Customer:

The United States Patent and Trademark Office ("Office") is now permitting and encouraging applicants to voluntarily submit amendments in a revised format as set forth in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, *Off. Gaz. Pat. Office* (February 25, 2003), currently available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>. The revised format permits amendments to the specification and claims to be made in a single marked-up version; the requirement for a clean version is eliminated. Attached, you will find a flyer with information and instructions regarding the procedures to be used to comply with the revised format. The flyers are being inserted with out-going Office actions mailed during the period of February 20, 2003 - March 31, 2003.

The revised amendment format is essentially the same as the amendment format for the specification, claims, and drawings that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. This proposed revision and others necessary to facilitate a gradual transition to the use of an Electronic File Wrapper (EFW) will be set forth in a Notice of Proposed Rule making (NPR), expected to be published by March 2003. After consideration of public comments, the Office anticipates adopting a revision to § 1.121, following publication of a Notice of Final Rule making (NFR), expected by June 2003, at which point compliance with revised § 1.121 will be mandatory.

The Office will continue to accept your amendment submissions in the revised format during the voluntary period, which will extend up to the effective date of final revisions to § 1.121. The Office also encourages your feedback on the proposed revised amendment format and other changes set forth in the NPR, expected to be published by March 2003.

For assistance: Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA), Legal Advisors Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). Alternately, you may send e-mail to "Patent Practice", the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures or telephone OPLA at (703) 305-1616.

A handwritten signature in black ink that reads "Nicholas P. Godici".

Nicholas P. Godici
Commissioner for Patents

Attachment: Flyer entitled: *Revised Notice* AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT*

Revised Notice*
AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT

The United States Patent and Trademark Office (USPTO) is permitting applicants to submit amendments in a revised format as set forth below. Further details of this practice are described in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, signed January 31, 2003, expected to be published in *Official Gazette* on February 25, 2003 (Notice posted on the Office's web site at <http://www.uspto.gov/web/offices/pac/dapp/olpla/preognotice/revamdtprac.htm>). The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003, at which point compliance with revised 37 CFR 1.121 will be mandatory.

Effective immediately, all applicants may submit amendments in reply to Office actions using the following format. Participants in the Office's electronic file wrapper prototype¹ receiving earlier notices of the revised practice may also employ the procedures set out below.

REVISED FORMAT OF AMENDMENTS

Begin on separate sheets:

Each section of an Amendment (e.g., Claim Amendments, Specification Amendments, Drawing Amendments, and Remarks) should begin on a separate sheet. *For example*, in an amendment containing a.) introductory comments, b.) amendments to the claims, c.) amendments to the specification, and d.) remarks, each of these sections must begin on a separate sheet. This will facilitate the process of separately indexing and scanning of each part of an amendment document for placement in an electronic file wrapper.

Two versions of amended part(s) no longer required:

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section or claim will be waived where an amendment is submitted in revised format below. The requirements for substitute specifications under 37 CFR 1.125 will be retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, or submission of a new claim, **must include a complete listing of all claims in the application**. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated – formerly claim #_), (previously reinstated), (re-presented – formerly dependent claim #_), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.
- (2) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" will include markings.
- (3) The text of pending claims not being amended must be presented in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.

¹ The Office's Electronic File Wrapper prototype program is described in *USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING*, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002) ("Prototype Announcement"), and applies only to Art Units 1634, 2827 and 2834.

- (4) A claim may be canceled by merely providing an instruction to cancel. Listing a claim as canceled will constitute an instruction to cancel. Any claims added by amendment must be indicated as (new) and shall not be underlined.
- (5) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word “claim” before the claim number is optional):

Claims 1-5 (canceled)
Claim 6 (withdrawn)
Claim 7 (previously amended): A bucket with a handle.
Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.
Claim 9 (withdrawn)
Claim 10 (original): The bucket of claim 8 with a wooden handle.
Claim 11 (canceled)
Claim 12 (re-presented – formerly dependent claim 11) A black bucket with a wooden handle.
Claim 13 (previously added): A bucket having a circumferential upper lip.
Claim 14 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification must be made by presenting a replacement paragraph or section marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per current 37 CFR 1.125.

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with § 1.84. An explanation of the changes made must be presented in the remarks section of the amendment. Any replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should **not** be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Any questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to the following legal advisors in the Office of Patent Legal Administration (OPLA): Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). For information on the waiver or legal aspects of the prototype, please contact Jay Lucas (Jay.Lucas@uspto.gov), Senior Legal Advisor (PCTLA) or Rob Clarke (Robert.Clarke@uspto.gov), Senior Legal Advisor (OPLA). Alternatively, further information may be obtained by calling OPLA at (703) 305-1616.

* Revised Notice: See Sec. B) for changes relating to substitute specifications, and Sec. C) for changes on replacement drawing practice.